

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC., HEWLETT-PACKARD COMPANY, and NETAPP, INC.
Petitioner,

v.

ELECTRONICS AND TELECOMMUNICATIONS RESEARCH,
INSTITUTE,
Patent Owner.

Case IPR2015-00549
Patent 6,978,346 B2

Before BRIAN J. McNAMARA, MIRIAM L. QUINN, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION

Denial of Institution of *Inter Partes* Review and
Denial of Motion for Joinder
37 C.F.R. § 42.108(b)
37 C.F.R. § 42.122(a) and (b)

I. INTRODUCTION

On January 8, 2015, Dell, Inc., Hewlett-Packard Company, and NetApp, Inc. (“collectively Petitioner”) filed a Petition (“Pet.”) for *inter partes* review of U.S. Patent No. 6,978,346 B2 (Ex. 1001, “the ’346 patent”). Paper 1. Patent Owner waived a Preliminary Response and concurrently represented it did not oppose joinder. Paper 8. Petitioner filed a Motion for Joinder (“Mot.”) to join this proceeding with *VMWare, Inc. v. Electronics and Telecommunications Research Institute*, Case IPR2014-00901 (“’901 IPR”).¹ Paper 5. We entered a Decision on Institution (“Dec. Inst.,” Paper 14) in the ’901 IPR on December 11, 2014. ’901 IPR, Paper 14. This case and the ’901 IPR both involve the ’346 patent.

The Petition for *inter partes* review and Motion for Joinder are denied.

II. ANALYSIS

A. Denial of Petition for Inter Partes Review

1. Background

The Petition asserts the asserted grounds are identical to those on which we instituted review in the ’901 IPR. Pet. 1; Mot. 7. In the ’901 IPR we instituted trial on the ground alleging that claims 1–9 were obvious under

¹ *International Business Machines Corporation v. Electronics and Telecommunications Research Institute*, Case IPR2014-00949 (“’949 IPR”) was joined previously into the ’901 IPR (’949 IPR, Paper 25) and all further filings in the joined proceeding are made in the ’901 IPR. Petitioner seeks joinder with the resulting ’901 IPR. Mot. 2 n. 1.

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35 U.S.C. § 103 over Mylex² and Hathorn.³ '901 IPR, Dec. Inst. 22. Hathorn and Mylex also were asserted in challenges against the '346 patent asserted in *Dell, Inc. v. Electronics and Telecommunications Research Institute*, Case IPR2013-00635 (“'635 IPR”). Petitioner in this case and in the '635 IPR are the same.

As relevant here,⁴ the '635 Petition challenged claims of the '346 patent on the following grounds: (1) claims 1–3 and 8 as obvious under 35 U.S.C. § 103(a) over Weygant and Mylex ('635 IPR Pet. 20–23); (2) claims 4 and 9 as obvious under 35 U.S.C. § 103(a) over Weygant, Mylex, and Serviceguard⁵ ('635 IPR Pet. 23–39); (3) claims 5–7 as obvious under 35 U.S.C. § 103(a) over Weygant, Mylex, and ANSI⁶ ('635 IPR Pet. 39–45); (4) claims 1–3 and 5–8 as anticipated under 35 U.S.C. § 102(b) by Hathorn ('635 IPR Pet. 45–60). On March 20, 2014, we instituted trial on the ground that claims 1–3 and 5–8 were anticipated under 35 U.S.C. § 102(b) by Hathorn, denying all other grounds on the merits. '635 IPR, Dec. Inst. 23–24. On February 27, 2015, we entered a Final Written Decision (“Final Dec.” Paper 39) finding that claims 1–3 and 5–8 of the '346 patent had not been shown to be unpatentable by a preponderance of the evidence. '635 IPR, Final Dec. 24.

² *Storage Area Networks; Unclogging LANs and Improving Data Accessibility*, Mylex Corporation, published May 29, 1998 (“Mylex,” Exs. 1006 and 1009).

³ U.S. Patent No. 5,574,950, issued Nov. 12, 1996 (“Hathorn,” Ex. 1005).

⁴ One ground is omitted from the list as not including Mylex or Hathorn.

⁵ *Managing MC/Serviceguard*, Hewlett-Packard Company, Jan. 1998 (“ServiceGuard,” Ex. 1004).

⁶ *Fibre Channel Arbitrated Loop (FC-AL-2)*, American Nat. Standards Inst., 1999 (“ANSI,” Ex. 1008).

2. *Legal Analysis*

a. *Claims 1–3 and 5–8*

Petitioner is estopped from requesting *inter partes* review in this case. Under 35 U.S.C. § 315(e)(1), once a Petitioner has obtained a final written decision, that Petitioner may not request or maintain subsequent proceedings on a ground that it “could have raised” during the prior proceeding.

Specifically, section 315(e)(1) provides:

(e) Estoppel. –

(1) Proceedings before the office.— The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, *may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.*

(Emphasis added).

The first requirement for estoppel is met because the Petitioner here and in the ’635 IPR are the same. The entry of the Final Written Decision in the ’635 IPR satisfies the second requirement. For the reasons that follow, we determine Petitioner could have raised the ground asserted in this case in the ’635 IPR.

What a Petitioner “could have raised” was described broadly in the legislative history of the America Invents Act (“AIA”) to include “prior art which a skilled searcher conducting a diligent search would reasonably could have been expected to discover.” 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Grassley). Indeed, the administrative estoppel codified in § 315(e)(1), as was pointed out, would effectively preclude petitioners from bringing subsequent

challenges to the patent in USPTO proceedings. *See id.* at S1376 (statement of Sen. Kyl) (“This [estoppel] effectively bars such a party or his real parties in interest or privies from later using inter partes review or ex parte reexamination against the same patent, since the only issues that can be raised in an inter partes review or ex parte reexamination are those that could have been raised in [an] earlier post-grant or inter partes review.”). We need not investigate what any search might have uncovered, for the record before us shows that the prior art references in the instant Petition were asserted in the ’635 IPR.

More specifically, the prior art Petitioner has asserted in the instant Petition, Mylex and Hathorn, was asserted in the ’635 IPR against all the claims of the ’346 patent. Hathorn was asserted as the basis of an anticipation ground under 35 U.S.C. §102. ’635 IPR Pet. 45–60. Mylex was asserted as one of a combination of references in three other obviousness grounds. *Id.* at 23–45. Petitioner asserted Mylex as disclosing a RAID controller limitation in the ’635 IPR (see, e.g., ’635 Pet. 20–21), where, in the instant Petition, the reference is asserted as disclosing a RAID (Pet. 21). On this record, the differences in how the references have been asserted in these proceedings have no weight on our determination of whether the grounds raised in the instant Petition could have been raised in the ’635 IPR. Both Mylex and Hathorn were known to Petitioner as prior art to the ’346 patent, and Mylex has been asserted as an obviousness reference in this Petition and in the ’635 IPR. It makes no difference to us that Petitioner may have believed Hathorn to be an anticipatory

reference in the '635 IPR, and that such a belief may have changed during the trial of the '635 IPR, where we ultimately determined in our Final Written Decision that Hathorn did not anticipate any claim of the '346 patent.

On this record, we determine that the combination of Mylex and Hathorn to show obviousness of claims of the '346 patent constitutes a ground that Petitioner could have raised in the '635 IPR. Accordingly, Petitioner is estopped under 35 U.S.C. § 315(e)(1) from asserting that ground now.

b. Claims 4 and 9

Notwithstanding the preceding, § 315(e)(1) operates as an estoppel only as to “review of a claim in a patent under this chapter that results in a final written decision.” 35 U.S.C. § 315(e)(1). The Final Written Decision in the '635 IPR resulted in a review of claims 1–3 and 5–8, but not of claims 4 and 9. '635 IPR, Final Dec. 24. This Petition challenges all of claims 1–9 as obvious over Mylex and Hathorn. Pet. 4. Thus, *inter partes* review of claims 4 and 9 is not precluded by the estoppel provisions of section 315(e)(1).

35 U.S.C. § 315(b) provides:

(b) Patent Owner’s Action. – An inter partes review may not be instituted *if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.* The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

(Emphasis added).

Absent joinder, the Petition here is barred under § 315(b) if it was filed more than a year after suit is served. The Petition shows the cases Petitioner lists as related, including those where each Petitioner has been the subject to a claim for infringement of the '346 patent. Pet. 1–2. We have taken judicial notice that each of the parties, the Petitioner here, was served with a complaint on December 3, 2012, more than one year before the January 8, 2015, filing date accorded to this case. Paper 6. As discussed below, we deny Petitioner's Motion for Joinder as to remaining claims 4 and 9. Absent joinder, claims 4 and 9 in this Petition are subject to § 315(b), and the Petition is barred.

B. Denial of Motion for Joinder

We exercise our discretion under 35 U.S.C. § 315(c) and decline to join claims 4 and 9 of this case to the '901 IPR. Section 315(c) provides:

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

(Emphasis added).

First, we note that Petitioner has the burden of showing that joinder should be granted, and nothing in the record shows us that joinder would be appropriate here for less than all the asserted claims. Further, in declining to join claims 4 and 9 to the '901 IPR we note that, were we to grant joinder, the case would proceed on different claims depending on the party. The '901 IPR has already been subject to joinder (see footnote 1) and has two

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Petitioners. Adding a third Petitioner (or more), with grounds that are limited to a small subset of the ongoing trial, will unnecessarily complicate the '901 IPR. In addition, while Patent Owner does not oppose joinder (Paper 8), we cannot ignore the additional time, effort and expense that will fall to Patent Owner. We are also cognizant that Patent Owner's statement of non-opposition does not address the present circumstances of our denial of institution on claims 1–3 and 5–8. On the present record, we are not inclined to join Petitioner to assert a ground partially, i.e., for two claims, but not the others.

ORDER

Accordingly, it is

ORDERED that *inter partes* review of U.S. Patent No. 6,978,346 is *denied*; and

FURTHER ORDERED that Petitioner's motion for joinder is *denied*.

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